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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/064,483 | 07/18/2002 | Bei-Chuan Chen | ASIP0003USA | 9691 |
| 27765 | 7590 | 02/07/2006 | EXAMINER | |
| NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116 | | | LOVING, JARIC E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2137 | |

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/064,483 | Applicant(s) CHEN ET AL. | |
| | Examiner Jaric Loving | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The claims being examined in this application are 1-12.

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank, Jr. et al., US 6,546,489 in view of Stevens US 2002/0133702.

In claim 1, Frank Jr. discloses a bootable software delivery device comprising:

a connection port for connecting the software delivery device to a computer

(Figure 3, item 426; col. 6, lines 32-51);

a microcontroller coupling the connection port for controlling the software delivery device (Figure 2, item 432; Figure 3, item 443; col. 5, lines 7-45; col. 6, lines 32-51 –

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two embodiments are provided where a microcontroller or microprocessor accomplish the same task); and

a disk drive coupling the microcontroller for storing a software (Figure 3, item 424; col. 6, lines 32-51);

wherein the microcontroller is so programmed that the software is executable by the computer from the software delivery device (col. 5, line 31 – col. 6, line 14; col. 6, lines 32-57 – disk drive can load memory image source and will only execute from the drive).

Frank, Jr. teaches all of the claimed elements except Frank, Jr. fails to teach the use of flash memory. Stevens teaches the use of flash memory as a nonvolatile storage device (paragraphs [0042]-[0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that it is advantageous for the software delivery device of Frank, Jr. to also incorporate Steven's use of flash memory storage. It is for this reason that one of ordinary skill in the art would have been motivated to enable Frank, Jr.'s secure boot device with flash memory because it provides flexibility in the devices the CPU can use to execute an initial set of instructions or to preserve data in the event of a power-off condition (Stevens, paragraphs [0042]-[0043]).

In claim 2, Frank, Jr., as modified, discloses the software delivery device of claim 1 wherein the microcontroller prevents copying of the software from the flash memory of the software delivery device (col. 5, line 31 – col. 6, line 14; col. 7, lines 39-60 –

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microcontroller or microprocessor will prevent the memory image source from being copied off the disk unless booted from the drive).

In claim 3, Frank, Jr., as modified, discloses the software delivery device of claim 1 wherein the connection port is an integrated drive electronics (IDE) port (col. 4, lines 30-37; col. 6, lines 32-35).

In claim 4, Frank, Jr., as modified, discloses the software delivery device of claim 1 wherein the connection port is a small computer system interface (SCSI) port (col. 4, lines 30-37; col. 6, lines 32-35).

In claim 6, Frank, Jr. discloses a software delivery device comprising for providing software copy protection, the software delivery device comprising:

a connection port for electrically connecting the software delivery device to a computer (Figure 3, item 426; col. 6, lines 32-51);

a microcontroller, electrically connected to the connection port, in which an authentication program is installed for booting the computer from the software delivery device (Figure 2, item 432; Figure 3, item 443; col. 5, lines 7-45; col. 6, lines 32-51; col. 7, lines 39 – col. 8, line 4 – verification code can be installed and sent on a remote computer system before access to the protected area is granted);

a disk drive electrically connected to the microcontroller, the disk drive comprising a boot sector for booting the computer in accordance with the authentication program (col. 5, line 31 – col. 6, line 14; col. 6, lines 32-57; col. 7, lines 39-60); and

a private program stored in the disk drive, the private program being executable by the computer only after booting from the boot sector is performed (col. 6, lines 4-14 – memory image will only boot after booting).

Frank, Jr. teaches all of the claimed elements except Frank, Jr. fails to teach the use of flash memory and the authentication program instructing the microcontroller to return a virtual boot sector. Stevens the use of flash memory (paragraphs [0042]-[0043]) and the authentication program instructing the microcontroller to return a virtual boot sector (paragraphs [0050] – [0051] and [0058] – [0061]). Stevens discusses a fail-safe boot in paragraph [0051] that boots from a different drive, which is similar to applicant's virtual boot sector and would only arise from commands in the BIOS.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that it is advantageous for the software delivery device of Frank, Jr. to incorporate Steven's use of flash memory and an authentication program instructing the microcontroller to return a virtual boot sector. It is for this reason that one of ordinary skill would have been motivated to enable Frank, Jr.'s secure boot device with flash memory because it provides flexibility in the devices the CPU can use to execute an initial set of instructions or to preserve data in the event of a power-off condition (Stevens, paragraphs [0042]-[0043]) and it would not only protect the software on the device during normal system operations, but during the boot process (Stevens, paragraphs [0003]-[0007]).

In claim 7, Frank, Jr., as modified, discloses the software delivery device of claim 6 wherein the microcontroller prevents copying of the private program from the flash

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memory of the software delivery device (col. 5, line 31 – col. 6, line 14; col. 7, lines 39-60).

In claim 8, Frank, Jr., as modified, discloses the software delivery device of claim 6 wherein the connection port is an integrated drive electronics (IDE) port (col. 4, lines 30-37; col. 6, lines 32-35).

In claim 9, Frank, Jr., as modified, discloses the software delivery device of claim 6 wherein the connection port is a small computer system interface (SCSI) port (col. 4, lines 30-37; col. 6, lines 32-35).

In claim 11, Frank, Jr., as modified, discloses the software delivery device of claim 6 wherein the authentication program is stored in a read only memory of the microcontroller (col. 5, line 46 – col. 6, line 14).

In claim 12, Frank, Jr., discloses a method for protecting a software, the method comprising: providing a device for delivering the software, the device comprising a drive for storing the software, a connection port for connecting to a computer, and a microcontroller for executing the software with the computer via the connection port; and programming the microcontroller in such a way that the software is executable by the computer only from the device (Figure 3, items 424, 426, 443; col. 5, line 31 – col. 6, line 14; col. 6, lines 32-57).

Frank, Jr. teaches all of the claimed elements except Frank, Jr. fails to teach the use of flash memory. Stevens teaches the use of flash memory as a nonvolatile storage device (paragraphs [0042]-[0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that it is advantageous for the software delivery device of Frank, Jr. to also incorporate Steven's use of flash memory storage. It is for this reason that one of ordinary skill in the art would have been motivated to enable Frank, Jr.'s secure boot device with flash memory because it provides flexibility in the devices the CPU can use to execute an initial set of instructions or to preserve data in the event of a power-off condition (Stevens, paragraphs [0042]-[0043]).

4. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank, Jr. and Stevens, and further in view of Strom et al., US 2004/0003274.

In claims 5 and 10, Frank, Jr., as modified, teaches all of the elements of claims 1 and 6, respectively, but fails to teach the software delivery device where the connection port is a universal serial bus (USB) port. Strom teaches utilizing a USB port in a method of content protection (paragraph [0023]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that it is advantageous for the software delivery device of Frank, Jr. to incorporate Strom's use of a USB port. It is for this reason that one of ordinary skill in the art would have been motivated to provide a USB port because it provides another interface in which other types of computer readable media may be used (Strom, paragraphs [0022]-[0023]).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Curran et al., US 4,525,599; Bakhoun, US 5,267,311; Ostrover

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et al., US 5,450,489; Schossow et al., US 5,467,396; Junya, US 5,860,094; Davis et al., US 6,401,208; Mattison, US 6,615,355; Lee, US 2002/0174353; Cromer et al., US 2003/0204754 and Moller et al., US 2003/0014653.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaric Loving whose telephone number is (571) 272-1686. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

JL